

Remarks

Claims 3-18 are in the case. Claims 1-2 were previously cancelled. No claim amendments are requested at this time. Claims 3-18 stand rejected. For the following reasons, reconsideration is respectfully requested.

In response to applicant's previous arguments, which are incorporated herein by reference, the Examiner takes the position that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant respectfully suggests that the Examiner is misconstruing applicant's argument. The Examiner has admitted that Reiley discloses all of the elements of the claimed invention with the exception of a plurality of ports on the tubular delivery member and a bone graft material including calcium sulfate. Applicant merely points out that there is nothing in the three cited references that would suggest combining all of the missing elements in the manner of the claimed invention. Thus, applicant is not attacking the cited references individually, but rather is pointing out that the references do not suggest the claimed invention, and therefore are not sufficient to establish a *prima facie* case of obviousness.

The question is whether the cited references suggest the claimed combination to a person of ordinary skill in the art. The differences between the prior art and the claimed invention are critical factors in making this determination. As the Supreme Court stated in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 694 (1966):

Under § 103, the scope and content of the prior art are to be determined; *differences between the prior art and the claims at issue are to be ascertained*; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Id., 86 S.Ct. at 694 (emphasis added). MPEP § 2142 recognizes that the cited references must teach or suggest **all** of the claim limitations, and that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In this case, applicant respectfully suggests that any suggestion to combine the cited references is based on applicant's disclosure, not the references themselves.

As applicant has previously noted, conspicuously missing from the cited references is any suggestion, teaching or motivation to use a needle having a radial port to deliver a bone graft material. It was applicant's recognition of this combination that allowed applicant to overcome the following disadvantages of the prior art bone graft delivery methods: (1) being unable to deliver bone graft material when the axial port abuts bone or other tissues, (2) not being able to radially inject bone graft material, and (3) requiring undesirable excessive force to eject bone graft material through the axial port. Of the three cited references, only the Sorensen reference teaches the use of a needle having radial ports. However, as far as the applicant can determine, Sorensen is concerned only with the discharge of fluids through the syringe. Nothing in Sorensen suggests the use of an axially and radially ported needle to discharge a paste or a bone graft material. Of the three cited references, only Kerr mentions the use of calcium sulfate bone paste materials. By combining three prior art references to provide the steps of the claimed method, it is respectfully suggested that applicant's disclosure is being used to reconstruct applicant's claimed invention, and that a *prima facie* case of obviousness has not been established.

Applicant respectfully requests reconsideration. If the Examiner concludes that a telephone interview would facilitate examination of this application, undersigned would welcome such a conference. It is believed that this response has been filed timely and that no extension of time is required, but if an extension is required, applicant hereby requests an appropriate extension of time. It is further believed that no fees are due, but if any fees or credits are due, the Commissioner is authorized to charge or deposit them to Deposit Account No. 502795.

Respectfully submitted,

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